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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

Stafford McLean, et al.

:

Examiner: Kim, Vickie Y.

U.S. SERIAL NO.: 09/901,362

:

Group Art Unit: 1614

FILED: JULY 9, 2001

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FOR: USE OF DELTA OPIOID RECEPTOR
LIGANDS AND SEROTONIN REUPTAKE
INHIBITORS IN THE TREATMENT OF
CHEMICAL DEPENDENCIES

:

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TERMINAL DISCLAIMER OVER A PRIOR PATENT

Your petitioner, PFIZER INC, a corporation organized under the laws of the State of Delaware, having its principal place of business at 235 East 42nd Street, New York, NY 10017-5755, certifies that it is the assignee of record of the entire right, title and interest in and to the present patent application, U.S. serial no. 09/901,362 filed a July 9, 2001 and the prior patent, U.S. patent 6,444,679, issued September 3, 2002 by virtue of an Assignment by the inventors in prior Provisional Application No. 60/121,156, filed February 22, 1999, from which priority is claimed under 35 U.S.C. §120 in the present application and the prior patent.

Pfizer Inc hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the present application (U.S. serial no. 09/901,362), which would extend beyond the expiration date of the full and complete statutory term of the prior patent (U.S. patent

6,444,679) wherein said full and complete statutory term is 06/09/2003 NVILLARI 00000005 16145 09901362

as defined in 35 U.S.C. §§154 to 156 and 173, including any term extensions thereto authorized or which may be authorized by law, and as presently shortened by any terminal disclaimer.

Pfizer hereby agrees that any patent granted on the present application shall be enforceable only for and during such period that the present application and the prior patent are commonly owned. This particular agreement runs with any patent granted on the present application and is binding upon the grantee and its successors or assigns.

In making the above disclaimer, Pfizer Inc does not disclaim the terminal part of any patent granted on the present application that would extend to the expiration date of the full and complete statutory term of the prior patent, wherein said full and complete statutory term is as defined in 35 U.S.C. §§154 to 156 and 173, including any term extensions thereto authorized or which may be authorized by law, and as presently shortened by any terminal disclaimer, in the event that the prior patent expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of common jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321, has all claims cancelled by a re-examination certificate, is reissued, or in any manner terminated prior to the expiration of its full and complete statutory term as presently shortened by any terminal disclaimer.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the present application or any patent that may issue from it.

The undersigned is an attorney of record in the present application. Please charge Deposit Account No. 16-1445 the fee set forth in 37 C.F.R. §1.20(d).

Respectfully submitted,

Date: May 19, 2003


Peter C. Richardson
Assistant Secretary
Pfizer Inc